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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,750	04/05/2001	Dwip N. Banerjee	AUS920010175US1	8858
24945	7590	07/14/2004	EXAMINER	
STREETS & STEELE 13831 NORTHWEST FREEWAY SUITE 355 HOUSTON, TX 77040			TRAN, QUOC A	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,750

Applicant(s)

BANERJEE ET AL.

Examiner

Quoc A. Tran

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/04/2002
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This action is responsive to application filed 04/05/2001.
2. Claims 1-30 are currently pending in this application. Claims 1, 9, 13, 14, 15, and 23 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

JF 1/12/04
4. Claims 1-30 are rejected under 35 U.S.C. ^{103(a)} ~~103(a)~~ s being unpatentable by

Olschafskie et al. US Patent No. 6,616,038 B1 issued 09/09/2003 filed 05/05/2000 (hereinafter '038), in view of Cantwell et al. US Pub No. 2001/0034738 A1 filed 02/22/2001 (hereinafter '738).

Claim 14 is representing of claim 13;

In regard to independent claim 14, *"printing an online document to generate an offline document; inscribing the offline document with one or more editing instructions selected from a predetermined set of editing symbols; scanning the inscribed offline document to create an online version of the inscribed offline document; identifying and*

locating the one or more editing instructions in the online version of the inscribed offline document; executing the one or more editing instructions at the identified locations", as taught by '083 at col. 2, line 13 through col. 3, line 25 (i.e. ... the information is printed by a printer in communication with the processor... The document (e.g., a book, a webpage, a legal brief, etc) 12 contains a plurality of graphic symbols... For purposes of the present application, "spatial symbology" is defined as an arrangement of marks, symbols or images configured to express a data message detectable and interpretable by a scanning device and microprocessor, such as but not limited to a pattern of wide and narrow spaces, dots, lines, or any layout of shapes and spaces... conventional OCR techniques can be used to capture the graphic symbols while the spatial symbology retrieves supplementary information), also taught by '083 at col. 4, lines 60-65 (i.e. ... The methods and apparatuses of the present invention provide a fast, reliable way to store, record, and reproduce written text...);

'083 does not explicitly teach, *"to form a subsequent online document"*, however '738 taught at page 3, paragraph [0025] (i.e..... The hard-copy documents go through a serial referral and approval process that is manually or automatically tracked using the workflow software.... Board clerk system 20 updates or more fields in electronic submittal form 102 to contain hyperlinks or URLs pointing to each of the agenda item documents associated with agenda item package... hyperlinks or URLs may be displayed on a Web page produced by board clerk 20 and accessible by the agenda participants. The associated agenda item documents are then indexed and

stored in clerk's repository 90 to facilitate subsequent electronic searching and retrieval).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of '038 that related to the method of managing an electronic document in an agenda process to form a subsequent online document. One of ordinary skill would be motivated to perform such a modification to rapidly and automatically modify large number of offline documents and reducing labor intensive of representing the subsequent online documents, as taught by '738 at page 1, paragraph [004] (i.e....overwhelming number of hard copy documents...).

In regard to independent claim 13, incorporate substantially similar subject matter as cited in claim 14 above, and in further view of the following, and is similarly rejected along the same rationale;

"Wherein the inscribed images include a combination of one or more text segments and one or more editing instructions", as taught by '038 at col. 2, line 40 through col. 3, line 65 (i.e. ... the information is printed by a printer in communication with the processor... The document (e.g., a book, a webpage, a legal brief, etc) ... It should be noted that the spatial symbology may be located anywhere in the multiple page text, such as in a footnote or endnote. ... the spatial symbology 21 is of abstract design. In FIG. 3(b) the spatial symbology is configured similar to morse code, and in FIG. 3(c) the spatial symbology is similar to bar code. As in previous embodiments, the spatial symbology may be used to identify a variety of information...);

'038 does not explicitly teach, "*identifying inscribed images in an online version of an offline document that are not in an online document that was used to produce the offline document*", however '738 taught at page 3, paragraph [0022] (i.e. Additionally, the agenda item documents comprise a variety of papers, including contracts, studies, reports, resolutions or proposed ordinance changes. If the documents are received in electronic format, such as via an attachment to an e-mail message, board clerk system 20 receives the documents. If the documents are received in hard-copy format, they are converted into electronic format using scanner 30 and then transferred to the board clerk system ...).

In regard to independent claim 9, incorporate substantially similar subject matter as cited in claims 13-14 above, and is similarly rejected along the same rationale.

In regard to dependent claim 10, "*creating the first text image by scanning an offline document that has been marked with the one or more editing instructions*", as taught by '038 at col. 3, line 13 through col. 3, lines 25-30 (i.e. ... conventional OCR techniques can be used to capture the graphic symbols while the spatial symbology retrieves supplementary information...).

In regard to dependent claim 11, "*preparing an online document incorporating the one or more text segments as modified by the one or more instructions*", as taught by '038 at col. 3, lines 20-35 (i.e. ... one set of spatial symbology can be used in accordance with the embodiments of the present invention, while another set of spatial symbology identifies the graphic symbols scanned... This embodiment of the invention

exploits the practice of publishing a given document in both paper and electronic form...).

In regard to dependent claim 12, *"generating the offline document by printing an online document"*, as taught by '038 at col. 2, lines 40-45 (i.e. ... printed document 12. The document (e.g., a book, a webpage, a legal brief, etc) ...).

In regard to independent claim 1, incorporate substantially similar subject matter as cited in claim 13 above, and is similarly rejected along the same rationale.

In regard to claims 2, and 8, incorporate substantially similar subject matter as cited in claim 11 above, and are similarly rejected along the same rationale.

In regard to claims 3, and 4, incorporate substantially similar subject matter as cited in claim 9 above, and are similarly rejected along the same rationale.

In regard to dependent claim 5, incorporate substantially similar subject matter as cited in claim 14 above, and is similarly rejected along the same rationale.

In regard to dependent claim 6, *"The method of claim 5, further comprising associating the images with the respective anchor points"*, as taught by '038 at col. 3, line 13 through col. 3, lines 40-45 (i.e. ... The data source 20 may include a digital version of the scanned text. The symbology may reference a portion of the text which can then be accurately saved. Alternatively, the data source 20 may contain information relevant to the subject matter of the scanned text. The spatial symbology may act as a link to information on the network and may provide the microprocessor with a network address or website where information related to the selected text may be found...).

In regard to dependent claim 7, *"The method of claim 6, further comprising storing the subsequent version of the online document in a redline format"*, as taught by '038 at col. 4, lines 5-18 13 (i.e. ... the spatial symbology overlay would eliminate pixels of the underlying graphic symbol and substitute the corresponding spatial symbology....).

In regard to independent claim 15, is directed to a system for performing the method of claim 1, and is similarly rejected along the same rationale.

In regard to dependent claim 16, is directed to a system for performing the method of claim 2, and is similarly rejected along the same rationale.

In regard to dependent claim 17, is directed to a system for performing the method of claim 3, and is similarly rejected along the same rationale.

In regard to dependent claim 18, is directed to a system for performing the method of claim 4, and is similarly rejected along the same rationale.

In regard to dependent claim 19, is directed to a system for performing the method of claim 5, and is similarly rejected along the same rationale.

In regard to dependent claim 20, is directed to a system for performing the method of claim 6, and is similarly rejected along the same rationale.

In regard to dependent claim 21, is directed to a system for performing the method of claim 7, and is similarly rejected along the same rationale.

In regard to dependent claim 22, is directed to a system for performing the method of claim 8, and is similarly rejected along the same rationale.

In regard to independent claim 23, is directed to a computer readable medium for performing the method of claim 1, and is similarly rejected along the same rationale.

In regard to dependent claim 24, is directed to a computer readable medium for performing the method of claim 2, and is similarly rejected along the same rationale.

In regard to dependent claim 25, is directed to a computer readable medium for performing the method of claim 3, and is similarly rejected along the same rationale.

In regard to dependent claim 26, is directed to a computer readable medium for performing the method of claim 4, and is similarly rejected along the same rationale.

In regard to dependent claim 27, is directed to a computer readable medium for performing the method of claim 5, and is similarly rejected along the same rationale.

In regard to dependent claim 28, is directed to a computer readable medium for performing the method of claim 6, and is similarly rejected along the same rationale.

In regard to dependent claim 29, is directed to a computer readable medium for performing the method of claim 7, and is similarly rejected along the same rationale.

In regard to dependent claim 30, is directed to a computer readable medium for performing the method of claim 8, and is similarly rejected along the same rationale.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Green et al. U.S. Patent No. 5,602,936 issued 02/11/1997 filed 02/27/1995

Schwartz U.S. Patent No. 6,214,901 B1 issued 04/10/2001 filed 03/07/1997

Thompson et al. U.S. Pub No. 2002/0103834 A1 issued 08/01/2002 filed 06/27/2001

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is (703) 305-8781. The examiner can normally be reached on Monday through Friday from 8:30AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER

Quoc A. Tran
Patent Examiner
Technology Center 2176
July 1, 2004